

B2 5. (amended) The sheet-shaped pack agent according to claims 3 or 4, characterized in that the base agent contains a moisturising agent 1-35 wt.%, a water soluble polymer 3-25 wt.%, and a cross-linking agent 0.05-20 wt.%.

B3 7. (twice amended) The sheet-shaped pack agent according to claim 1, further comprising a glycol.

B4 10. (twice amended) The sheet-shaped pack agent according to claim 1, characterized in that the fruit extract comprises one or more species selected from the group consisting of rose fruit extract, orange extract, orange juice, raspberry extract, kiwi extract, cucumber extract, gardenia extract, grapefruit extract, crataegus fruit extract, Japanese pepper extract, crataegus extract, common juniper extract, jujube extract, duke extract, tomato extract, grape extract, lime juice, apple extract, apple juice, lemon extract and lemon juice.

11. (twice amended) The sheet-shaped pack agent according to claim 1, constructed and arranged for use in cosmetics for the skin or delivery of a quasi-drug.

Remarks

Applicant has amended claims 7 and 11 to clarify the claim language. Support for the amendment to claim 7 is found in the claim as filed. Support for the amendment to claim 11 is found in the specification, for example at page 3, lines 17-19 and page 14, lines 8-13. Claim 10 was amended to remove loofah extract from the group of fruit extracts. Claim 1 was amended to more clearly differentiate the claimed invention; support for the amendment is found, for example, in claim 5 as filed. Claim 5 was amended to remove the feature now recited in claim 1 as amended. No new matter has been added.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claim 11 as vague and indefinite. Applicants have amended the claims to clarify claim 11. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 11 made under 35 U.S.C. § 112, second paragraph.

Claim Rejections Under 35 U.S.C. § 103

The Examiner rejected claim 1-11 as unpatentable over JP 08-040882 in view of JP 08-188527. The Examiner suggests that the JP 08-040882 reference teaches a sheet pack that contains a polysaccharide extracted from seaweed, and that the sheet pack also contains fruit extracts. The Examiner then asserts that the element missing from the JP 08-040882 reference, a glycol, is provided by the JP 08-188527 reference. Applicants respectfully traverse the rejection.

First, the present invention is made by adding a fruit extract to a sheet-shaped pack agent substantially as disclosed in JP 08-188527. The most important difference between the present invention and the product disclosed in the JP 08-188527 reference is the presence or absence of fruit extract. In contrast, JP 08-040882 relates to a skin patch sheet made from dried polysaccharide obtained from seaweed, which also can contain a fruit extract.

However, since the skin patch of JP 08-040882 is a dried product, its texture, production method and mode of use differ from those of the sheet-shaped pack agent of JP 08-188527 as well as the present invention, both of which are wet products. Therefore, it is not appropriate to combine the teachings of the skin patch sheet as described in JP 08-040882 with the pack agent of JP 08-188527 in rejecting the claims of the present invention.

There is no suggestion in JP 08-188527 to add fruit extract, whereas in JP 08-040882 the fruit extracts are merely listed as an optional example from various kinds of extracts such as animal tissue, plant, or crude drug (see paragraph [0013]). Although it is also stated in JP 08-040882 that these extracts are used as a moisturizing component, or for the purpose of various cosmetic or medical effects, this description does not teach any specific effects of the fruit extract. Moreover, there are no examples in JP 08-040882 which explicitly show the beneficial effects of the fruit extract.

Based on the teachings of the JP 08-040882 and JP 08-188527 references, one of ordinary skill in the art would not be motivated to combine the references. In particular, there is no motivation to add a fruit extract to the pack agent of JP 08-188527 given that there is no teaching of such an addition to a related pack agent (as noted above, the skin patch sheet of JP 08-040882 has a fundamentally different composition). Therefore, a *prima facie* case of obviousness has not been made by the Examiner.

Second, the Examiner has not provided a valid motivation to combine the two cited references. The primary reference (JP 08-040882) teaches a sheet-type pack made from freeze-dried agarose, a polysaccharide obtained from seaweed. In contrast, the secondary reference (JP 08-188527) teaches a sheet-type pack made from water soluble polymer such as gelatin, a polyhydric alcohol such as a glycol, humectants, curing agents, and water. The sheet-type pack of JP 08-188527, like the pack agents of the present invention, has a high water content and is not freeze-dried, in contrast to the sheet-type pack of JP 08-040882.

Based on the teachings of the references as discussed above, one of ordinary skill in the art would not be motivated to combine the primary reference with the secondary reference teaching the addition of glycol. Applicant notes that the JP 08-040882 reference does mention the inclusion of glycol in paragraph [0019]. There is no motivation provided in either of the references for the person of skill to substitute or combine the elements of the references to obtain the claimed invention.

As is well established in the law, an effective obviousness rejection is based on references that provide a specific motivation for a skilled artisan to combine references in such a way as to obtain the claimed invention. This was not achieved by the rejection issued by the Examiner.

The requirement for a specific motivation to combine the teachings of prior art references was recently set forth by the Court of Appeals for the Federal Circuit in In re Sang Su Lee. Applicants provide below an excerpt for the convenience of the Examiner.

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

"The factual inquiry whether to combine references must be thorough and searching." Id. ***It must be based on objective evidence of record.*** This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of

the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

In re Sang Su Lee, slip op. 7-9 (Fed. Cir. 2002) (emphasis added except where noted).

The references do not provide the specific motivation to combine because, as noted above, the references provide products that are fundamentally different in composition (dried vs. wet types). One of ordinary skill in the art would not be motivated to make the combination simply because the both references relate to similar products, without more substantial commonality between the teachings of the references. Accordingly, Applicants assert that the Examiner has not met the burden to provide specific motivation to combine.

In view of the foregoing, Applicants respectfully request that the Examiner withdraw the rejection of claims 1-11 made under 35 U.S.C. § 103(a).

CONCLUSION

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,



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Amended Claims

1. (amended) A sheet-shaped pack agent comprising a base agent containing 60-95 wt.% of water and a fruit extract whose density is 0.95-1.20, the pH is 3.3-5.0 and the sugar content is 19-23 wt.%.

5. (amended) The sheet-shaped pack agent according to claims 3 or 4, characterized in that the base agent contains a moisturising agent 1-35 wt.%, a water soluble polymer 3-25 wt.%, and a cross-linking agent 0.05-20 wt.% [and water 60-95 wt.%].

7. (twice amended) The sheet-shaped pack agent according to claim 1, [characterized in that] further comprising a glycol [is further contained].

10. (twice amended) The sheet-shaped pack agent according to claim 1, characterized in that the fruit extract comprises one or more species selected from the group consisting of rose fruit extract, orange extract, orange juice, raspberry extract, kiwi extract, cucumber extract, gardenia extract, grapefruit extract, crataegus fruit extract, Japanese pepper extract, crataegus extract, common juniper extract, jujube extract, duke extract, tomato extract, grape extract, [loofah extract,] lime juice, apple extract, apple juice, lemon extract and lemon juice.

11. (twice amended) The sheet-shaped pack agent according to claim 1, [characterized in that it is used as] constructed and arranged for use in cosmetics for the [beauty] skin or delivery of a quasi-drug.